IN THE

Supreme Court of the United States

October Term, 1953
No. 446

ROBERT E. OVERMAN,

Petitioner,

vs.

FRANK LOESSER,

Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

Opinions Below.

In addition to the opinion of the District Court to which petitioner refers [R. 837-839] there were some comments by the District Judge, made in denying petitioner's motion for a new trial, which amplify and supplement his original opinion. [R. 839-843.]

The opinion of the Court of Appeals [R. 936] is reported in 205 F. 2d 521.

Jurisdiction.

The jurisdiction of this Court is properly invoked under 28 U. S. Code, sec. 1254(1).

Questions Presented.

1. When, in a case in which it is claimed that a copyrighted musical composition has been unauthorizedly copied by the defendant, there is substantial evidence which, if true, establishes that the defendant's composition was composed, reduced to writing, and performed on several occasions, one year or more before the plaintiff's copyrighted composition was composed, and that evidence is accepted as true by the District Judge who saw and heard the witnesses, should it be held that the District Court's finding of no copying is clearly erroneous?

2. Does evidence of the sort described above, accepted as true by the District Judge, satisfy the defendant's burden of establishing that he did not copy, by evidence which is "clear, satisfactory and beyond a reasonable doubt," assuming that to be the proper criterion of persuasion in the circumstances involved?

Statement of the Case.

The respondent Frank Loesser is a professional composer of music, who has written a large number of successful popular songs. [R. 223-224.] In the summer of 1942 it occurred to Loesser that the well-known card-player's phrase "I'd like to have you on a slow boat to China" might be made the basis of a song. As was his custom when such thoughts came to him, he made a written note of the idea and filed it with similar memoranda which he had made from time to time. The original note and the envelope in which it (and the other memoranda) had been kept were produced at the trial. [R. 287, 289, 754-755; Exs. A, G.]

In the early part of 1943, while on duty with the Air Force at Santa Ana, California, Loesser in his spare

time worked on the development of that phrase into a song. By January 1, 1944, when he left the Santa Ana post, Loesser had composed the first eight bars and accompanying lyrics of the song in the identical form in which it was ultimately published as "On A Slow Boat To China."[1] [R. 291-295.] During this period Loesser played and sang the number, to the extent that it had then been composed, for Milton DeLugg, a fellow soldier and himself a musician and composer. Both Loesser and DeLugg so testified below. [R. 296, 319-321.]

Loesser was separated from the service in September or early October, 1945. During the process of separation and for a short time thereafter he continued with his development of the "slow boat" theme. By the end of November, 1945, he had worked out the words and music of the song in their entirety and as they exist today.[2] [R. 296-298.]

Loesser then "dictated" the song to DeLugg, who was acting as his musical secretary. The dictation consisted of vocal and piano renditions of the composition by Loesser in DeLugg's presence. The latter transcribed what he saw and heard into a lead sheet or musical "sketch." This consisted of the musical notation of the full melody, exactly as played (except for the erroneous transcription of one D-note as a C) and an indication or "sketch" of the harmonic accompaniment. This dictation took place

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[1]So-called popular music almost invariably consists of sixteen bars repeated, as does "On a Slow Boat to China." By January 1, 1944, therefore, the accused song was already half composed.

[2]When published, a four-bar interlude was added. [R. 634.] No claim has ever been made that this addition was copied from petitioner's song.

in December, 1945; and the original manuscript thus produced was placed in evidence. [R. 299, 303-308, 322, 583-584, 755; Ex. H.] Both Loesser and DeLugg denied any copying from petitioner's song or any knowledge of its contents at any time prior to 1947. [R. 365, 588-589.]

From time to time in the latter part of 1945 and the early part of 1946 Loesser on various occasions played and sang "On A Slow Boat To China" for a number of people. Seven of these auditors—each one wholly disinterested, each one a professional musician or music publisher, and each one having a special or personal reason for remembering the occasion—testified to these renditions and to the fact that as then played and sung (one year or more *before* petitioner's song was composed) it was exactly or substantially identical with the song in its later published form. Six of these witnesses testified in person at the trial; the testimony of the seventh was produced by deposition. [R. 717-719; 591-601; 603-611; 464-468; 535-540; 614-615; 620-622; 633-636; 456-461; Ex. M.] In several instances the witnesses' recollection of dates was corroborated by business and employment records of corporations having no connection of any kind with the litigation. [Exs. Q, S, T, U, V.] None of these witnesses was impeached or contradicted.

The District Judge accepted this testimony as true. [R. 837-839, 843.] Accordingly, he found as facts that Loesser's song was composed in November, 1945; that the petitioner's work was not composed until September or October, 1946, and was not submitted to Loesser until January 27, 1947; and that Loesser did not copy any part of "On A Slow Boat To China" from petitioner's song. [R. 13-15.] Furthermore, in denying a motion for new

trial (in support of which it was vigorously argued for the first time in the cause, that Loesser had not carried his burden of establishing prior conception by evidence that was "clear and satisfactory or beyond a reasonable doubt" [R. 18, 19]) the District Judge declared unequivocally that he was *"convinced"* by the evidence, to which we have referred, that Loesser's song had been composed long before petitioner's. [R. 843.]

The Court of Appeals affirmed. It held, as contended for by petitioner, that the rule of burden of proof announced in *Hoeltke v. C. M. Kemp Mfg. Co.*, 4 Cir., 80 F. 2d 912, *certiorari denied*, 298 U. S. 673, was applicable; but that the burden thus cast on the defendant had been successfully carried by evidence "which if believed would make a finding of copying untenable . . ." Therefore, the Court concluded, since that evidence was believed by the trial court, the finding of no copying based thereon, involving, as it did, the credibility of witnesses, and which was supported by substantial evidence, was conclusive on appeal.[3] [R. 939-940, 941-942.]

In that holding, we submit, there was neither error nor conflict with any applicable decision.

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[3]Since both the District Court and the Court of Appeals considered the evidence in the light of the standard of persuasion for which petitioner argues and held that there had been no copying, the evidence relating to the supposed relation of trust and confidence between petitioner and Loesser becomes immaterial. Even in petitioner's view of the law the only significance of that relationship is that procedurally it serves to impose on the defendant a more onerous burden of proof than might otherwise have been his, and that substantively, it subjects the latter to liability if he unauthorizedly makes use of the disclosed information. Accordingly, we do not extend this brief by a summary of that evidence or a correction of petitioner's statement of it. [But see, Note 8, *infra*.]

Argument.

1. The evidence to which reference has been made, if true, conclusively establishes that Loesser's song was composed many months before petitioner's number was in existence. On the indicated assumption of truth, it is obvious that the defense of prior conception was established, not only beyond reasonable doubt, but beyond any doubt whatever. Thus it is at once apparent that the basic, in fact the only, question before the District Court was whether the nine witnesses who gave that testimony spoke the truth. The District Judge, having the advantage of seeing and hearing the witnesses, found that they had testified truthfully. There can be no doubt that the rule in those circumstances is, in the words of Mr. Justice Holmes, "that so far as the finding of the master or judge who saw the witnesses 'depends upon . . . the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable.' . . ."[4] [*Adamson v. Gilliland,* 242 U. S. 350, 353, 61 L. ed. 356, 37 S. Ct. 169. To the same effect: *Alabama Power Co. v. Ickes,* 302 U. S. 464, 477, 82 L. ed. 374, 377, 585 S. Ct. 303; *United States v. Aluminum Co. of America,* 2 Cir., 148 F. 2d 416, 433; *Wittmayer v. United States,* 9 Cir., 118 F. 2d 808, 811. And see, *United States v. Oregon Medical Society,* 343 U. S. 326, 339, 96 L. ed. 978, 988, 72 S. Ct. 690.]

That is the rule whether the burden of proof or standard of persuasion be a "preponderance of the evidence,"

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[4]While this rule was formulated under the old equity practice it is equally applicable now, since F. R. C. P. rule 52(a) perpetuated that practice. [*United States v. U. S. Gypsum Co.,* 333 U. S. 364, 394-395, 92 L. ed. 746, 765-766, 68 S. Ct. 525.]

or "clear and satisfactory evidence," or "proof beyond a reasonable doubt." In any case, and regardless of which burden applies, the question whether the evidence comes up to the required standard is one for the trial court. On review, the only question is whether the evidence, accepted as true below, supports the finding based thereon. That is just as much the rule in that rare type of civil case in which the reasonable doubt burden is imposed [*Waterloo Register Co. v. Atherton,* 9 Cir., 38 F. 2d 75, 76; *Becker v. Electric Service etc. Co.,* 7 Cir., 98 F. 2d 366, 368; *Twyman v. Radiant Glass Co.,* 8 Cir., 56 F. 2d 119, 120] as it is in criminal cases in which it is the usual criterion. [*Glasser v. United States,* 315 U. S. 60, 80, 86 L. ed. 680, 704, 62 S. Ct. 454, 469; *Moore v. United States,* 150 U. S. 57, 61-62, 37 L. ed. 996, 14 S. Ct. 26; *United States v. Manton,* 2 Cir., 107 F. 2d 834, 839, *certiorari denied,* 309 U. S. 664, and cases there cited; *Craig v. United States,* 9 Cir., 81 F. 2d 816, 827, *certiorari denied,* 298 U. S. 690; *Noell v. United States,* 9 Cir., 183 F. 2d 334, 336, *certiorari denied,* 340 U. S. 921; *CO-Two Fire Equipment Co. v. United States,* 9 Cir., 197 F. 2d 489, 491, *certiorari denied,* 344 U. S. 892 (jury waived).] It is also the rule in those cases in which the burden is not so severe as reasonable doubt but more stringent than mere preponderance, *e.g.,* "clear and satisfactory" evidence or a "heavy" burden. [*Carr v. Yokohama Specie Bank,* 9 Cir., 200 F. 2d 251, 255; *Lorenz v. Colgate-Palmolive-Peet Co.,* 3 Cir., 167 F. 2d 423, 425.]

It follows that specification of the particular criterion which is applicable in the instant cause is unnecessary and immaterial. The found truthfulness of the evidence of prior conception established that fact beyond any possible

question and thus satisfied even the most onerous burden of proof known to the law.

2. In point of fact, both the District Court and the Court of Appeals applied the standard for which petitioner argues. As has been seen, the contention that the defendant was required to prove prior conception beyond a reasonable doubt was belatedly advanced to the District Judge who nevertheless pronounced himself "convinced." [R. 19-20, 843.]

The Court of Appeals, stating that the dictum of *Hoeltke v. C. M. Kemp Mfg. Co., supra,* 80 F. 2d 912, was applicable, as petitioner contended, ruled that the evidence favorable to Loesser, if true, met the requirements of that rule; and that it was for the trial court who saw the witnesses, not the Court of Appeals to determine whether it was true.[5] [R. 939-942.] That disposition of the matter squares not only with *Hoeltke* but with all of the cases on scope of appellate review. [See, F. R. C. P., Rule 52(a).]

3. The Court of Appeals did not misconstrue or raise a conflict with the *Hoeltke* case. The original opinion in the latter case must certainly be read together with and as supplemented or modified by the opinion rendered in denying a rehearing. The Court of Appeals so read it in the instant cause; and so read it is clear that what was held in *Hoeltke* was only that unsupported testimony of *interested* witnesses, inconsistent with other established

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[5]Actually, the Court did not apply the reasonable doubt or heavy burden rule in *Hoeltke*. What was there decided, as distinguished from discussed, was that the evidence even by ordinary civil standards, was insufficient to support the finding of independent conception. [80 F. 2d at 923-924.]

or conceded facts, is not enough to carry the burden of proof imposed in cases of the sort there involved.[6] [See, note 5, *supra.*]

That this was a correct reading of *Hoeltke* is shown by the subsequent history of the decision in the same court which decided it. In *Chesapeake & O. Ry. Co. v. Kaltenbach,* 4 Cir., 95 F. 2d 801, 806, in an opinion in which Judge Parker, the author of the *Hoeltke* opinions concurred, only the rehearing opinion (in which the burden was said to be a "heavy one") was quoted. That quotation was introduced with the comment that it was a "*full* discussion" of the question. [Italics ours.] In *Ackermans v. General Motors Corp.,* 4 Cir., 202 F. 2d 642, 646, Judge Parker, apparently weighing the evidence *de novo,* concluded that the testimony of independent conception given by the defendant's *employees* was not convincing because the employees worked along lines laid out for them by the defendant; and because a particular employee, who was an alleged co-inventor of defendant's device and had knowledge of plaintiff's invention, was in court but was not called to testify that his work on the invention was independent of plaintiff's conception. In support of that holding Judge Parker quoted from both

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[6]In the case at bar the testimony of the interested witness was supported by the testimony of eight *disinterested* witnesses who, in turn, were corroborated in important particulars by business and employment records of disinterested concerns; and none of that evidence was inconsistent with any other fact in the record. [*Cf., Baker v. Dean,* 9 Cir., 80 F. 2d 658, 659; *Rown v. Brake Testing etc. Corp.,* 9 Cir., 38 F. 2d 220, 224; *Waterloo Register Co. v. Atherton, supra,* 38 F. 2d at 76; *Becker v. Electric Service etc. Co., supra,* 98 F. 2d at 368.] This substantially different factual situation, even when tested, as it was, by *Hoeltke* standards, required a different conclusion as to the sufficiency of the evidence to support the finding which was made in the trial court.

of his *Hoeltke* opinions, thus clearly indicating that the two must be read together.

Apart from the instant case, these decisions by the same court which decided *Hoeltke,* are the only appellate decisions citing the latter to the point here under discussion. The Court of Appeals did no more at bar with *Hoeltke* than its authors had already done with it.

4. At pages 12-13 of the petition a number of cases are listed as having cited *Hoeltke;* and, while the petitioner does not say so expressly, he obviously seeks to convey the impression that these citations were in support of the proposition that prior conception must be shown beyond a reasonable doubt. The fact is that in every instance given (aside from the two decisions just discussed), *Hoeltke* was *not* cited for that or any similar proposition, but for another point entirely.[7] Obviously there is no room in that treatment of the decision for any claim of a conflict among the circuits in respect of the *question raised at bar.*

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[7]For a typical example take *Eckert v. Braun,* 7 Cir., 155 F. 2d 517, 519, which petitioner lists as holding "that the cases are uniform on the point," presumably, the burden of proof point. What was actually said in that case follows:

> "The cases are uniform in holding that 'where, in advance of the granting of a patent, an invention is disclosed to one who, in breach of the confidence thus reposed, manufactures and sells articles embodying the invention, such person shall be held liable for the profits and damages resulting therefrom, *not under the patent statutes* but upon the principle that equity will not permit one to unjustly enrich himself at the expense of another,' Hoeltke v. Kemp Mfg. Co., 4 Cir., 80 F. 2d 912, 923, Chesapeake & O. R. Co. v. Kaltenbach, 4 Cir., 95 F. 2d 801, Saco-Lowell Shops v. Reynolds, 4 Cir., 141 F. 2d 587. . . ." [Court's italics.]

5. Questions of "access" and "similarity" are wholly immaterial in view of the finding that there was no *copying*. A copyright does not secure to an author or composer a monopoly in his conception or result; it gives to him, for a limited term, no more than the right to prevent others from *copying* his work. [*Arnstein v. Edw. B. Marks Music Corp.*, 2 Cir., 82 F. 2d 275; *Nutt v. National Institute*, 2 Cir., 31 F. 2d 236, 237; *Harold Lloyd Corp. v. Witwer*, 9 Cir., 65 F. 2d 1, 4, *appeal dismissed*, 292 U. S. 669; *Ricker v. General Elec. Co.*, 2 Cir., 162 F. 2d 141, 142.] The function of evidence of access and similarity in a copyright infringement case is to furnish the premise from which an inference of copying may be drawn. Such an inference is never compelled, and like any inference, may be negated by other evidence. [*Darrell v. Joe Morris Music Co.*, 2 Cir., 113 F. 2d 80; *Arnstein v. Edw. B. Marks Music Corp., supra*, 82 F. 2d 275; *Kustoff v. Chaplin*, 9 Cir., 120 F. 2d 551, 560.] When the evidence opposed to the inference is believed by the trial judge to be true and a finding is made conformably to that determination, the situation on appeal is only the familiar one of conflicting evidence resolved one way rather than the other. [*United States v. Yellow Cab Co.*, 338 U. S. 338, 341-342, 94 L. ed. 150, 153, 70 S. Ct. 177; *United States v. National Ass'n of Real Estate Boards*, 339 U. S. 485, 495-496, 94 L. ed. 1007, 1016, 70 S. Ct. 711; *Graver Tank Co. v. Linde Air Products Co.*, 339 U. S. 605, 609-610, 94 L. ed. 1097, 1103, 70 S. Ct. 854.]

6. Similarly, the finding of no copying rendered immaterial the question whether a confidential relationship existed between the parties.[8] [Pet. 22-23.] That relationship became of significance, in relation to the substantive rights of the petitioner, only if it was abused by the defendant, *i.e.*, if the composition claimed to have been confidentially disclosed to the latter was unauthorizedly appropriated by him. Since, as the District Court found, it was not appropriated at all, the issue of confidential relationship *vel non* necessarily dropped out of the case. [*Swan Carburetor Co. v. Nash,* 4 Cir., 133 F. 2d 562, 566-567.]

7. The argument for public importance seems to be that it is essential for authors and composers to be able to submit their works to prospective publishers without fear of having their compositions misappropriated. [Pet. 11.] That proposition may be granted without thereby giving to the case at bar any attribute of public significance. Nothing in the decision of the Court of Appeals affects in the slightest the protection which the law now offers to persons situated as was petitioner. Rights secured by statutory copyright are in no wise impaired;

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[8]At least a doubt may be expressed as to whether a casual and obviously conversation-making suggestion from a chance acquaintance that petitioner might submit his work to Loesser, as was the situation at bar [*e.g.,* R. 89-91, 96, 141, 147-148], was enough to create the relationship. [See, *Robins v. Hope,* 57 Cal. 493, 496-497; *Bacon v. Soule,* 19 Cal. App. 428, 434, 436-437, 126 Pac. 384, 386-387; *Herbert v. Lankershim,* 9 Cal. 2d 409, 483-484, 71 P. 2d 220, 257; Restatement, *Restitution,* sec. 182, comment c.]

nor is there any narrowing of a misappropriator's liability which may arise from contractual or fiduciary relationships. All that has been held is that when a claim of such misappropriation is made, a finding of fact to the contrary will not be disturbed on appeal if it is supported by substantial evidence believed to be true by the trier of the fact, who saw and heard the witnesses. Certainly, the desirability, even the necessity, of protecting authors and composers does not require that ordinary and long-established principles of appellate review must be overturned. Much less does it require that defendants be held to a standard of proof which in practice would make it impossible ever to establish that their work was their own.[9] [*Cf., Rown v. Brake Testing etc. Corp., supra,* 38 F. 2d at 224, stating that if courts could disregard credible, unimpeached testimony of prior conception in patent cases the statutory provision for such a defense would be nullified by "exacting an impossible standard of evidence . . ."]

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[9]It is important to note that in cases, such as *Hoeltke,* in which a heavy burden is placed on the defendant to prove independent conception, the defendant's composition or invention admittedly did not come into being until *after* the plaintiff's work had been disclosed. In such circumstances, there can be seen some reason for requiring a strong showing that the defendant's mental processes were not influenced by that which had been previously disclosed and of which, it must be assumed, he was aware while doing his own work. In the instant case, however, the whole point of the defense was that the defendant's composition came *before* any disclosure and, therefore, could not have been influenced by it.

Conclusion.

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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